

## **REMARKS**

The Office Action dated March 2, 2004 has been received and carefully studied. Claims 57, 85 and 95 have been amended and claims 35-37, 44-47, 68-84, and 105-108 have been canceled. Claims 1-34, 38-43, 48-67, and 85-104 are in the application and stand rejected. Reconsideration is respectfully requested.

### **1. Drawings**

The applicants acknowledge the Examiner's indication that the figures are suitable for examination and publication but are otherwise considered informal. Given that no objections have been raised, the applicants will defer submission of formal drawings until the allowance of the claims.

### **2. Rejections for Indefiniteness**

The Examiner has rejected claims 57, 67, and 74 for indefiniteness on the grounds that the claims include a trademark. Claims 67 and 74 have been canceled. Claim 57 has been amended to replace "Spectrum 24" with a general recitation of a wireless data communication protocol. Accordingly, the indefiniteness rejection of claim 57 has been traversed and the rejection should be withdrawn.

### **3. Rejections under 35 U.S.C. § 103**

#### **A. General Statements Regarding Official Notice**

The Examiner has rejected all of the pending claims as being obvious over U.S. Patent No. 6,434,530 to Sloane et al. ("Sloane"). Sloane discloses an interactive

shopping system in which customers use a portable device to scan items while shopping. The Examiner admits that Sloane does not explicitly recite all of the various features recited in the independent claims but addresses the deficiencies in the Sloane disclosure by stating that the Sloane system can provide generic “supplemental information required to make intelligent shopping decisions ... and enable manufacturers to influence shopping decisions.” Even if the Sloane system can provide generic information, this is entirely different from the specific features and information recited in the rejected claims, which features and information the Examiner has apparently extrapolated from his generic contention and supports adding to Sloane only by reliance on Official Notice unsupported by documentary evidence.

As specified in MPEP § 2144.03, “[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known . . . It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. . . . For example, assertions of . . . specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art . . . and be capable of such instant and unquestionable demonstration as to defy dispute.” (Emphasis in original; internal quotations and citations omitted.) Id. The Examiner’s present Official Notice positions do not meet the these requirements and the obviousness rejections over Sloane in view of official notice are improper.

Applicants acknowledge that certain aspects of the Sloane shopping system are somewhat similar to the claimed invention but disagree that with the Examiner that all of the claims are obvious. As explained in more detail below, many of the claims recite features for which Sloane contains no teaching or suggestion and the Examiner's modification of Sloane to include these features, supported by Official Notice, appears instead to be impermissible use of hindsight. To the extent that the Examiner maintains rejections of the pending claims, the applicants respectfully ask the Examiner to provide specific support for each use of Official Notice in the claim rejections.

Because the Examiner has not identified the specific features in the rejected claims which are absent from Sloane and on which Official Notice is based, applicants contend that the rejection based on Official Notice is defective for this additional reason. Indeed, without a specific identification of the feature for which Official Notice is based, the applicants are unable to specifically address them, and therefore address the Official Notice rejections generally.

B. Independent Claims 1, 3, 85, and 95

Independent claims 1 and 13 recite, respectively, a method and system for marketing wherein the system provides a product coupon "by dynamically changing a characteristic of the product coupon based on whether or not the customer is in the at least one database." Similarly, independent claims 85 and 95 recite, respectively, a method and system for marketing which "dynamically chang[es] an amount of the product coupon." A particular example of such dynamic changing is addressed in the paragraph spanning pages 1-2 of the Specification as filed.

Although Sloane discloses printing of product coupons, there is no teaching or suggestion in Sloane to dynamically change a characteristic of the product coupon as recited in claims 1 and 13 or to dynamically change an amount of a product coupon as recited in claims 85 and 95. Applicants contend that this feature is not common knowledge or well-known in the art and that the rejection of these claims as being obvious over Sloane in view of unsupported Official Notice rejection has therefore been traversed. Accordingly, the rejection of claims independent claims 1, 13, 85, and 95, as well as the respective dependent claims, should be withdrawn. If the Examiner maintains his rejection on the basis of Official Notice, applicants request that the Examiner produce documentary support for this position.

C. Independent Claims 25 and 30

The Examiner has rejected claims 25 and 30 “for substantially the same reasons as claim 1”, again basing the rejection on the generic Official Notice that the features recited in these claims and not disclosed in Sloane are well known. Applicants disagree.

Sloane does not teach or suggest the use of a point system to reward a customer for use of the scanning system. In contrast, claims 25 and 30 recite a method and system, respectively, for marketing which includes “assigning scanning points to a customer in response to at least the reading of a bar code by the customer with one of the wireless bar code reading terminals and adding the scanning points to the scanning point account of the customer”. While a “green stamp” program is a known method of awarding points to a customer in response to the purchase of goods or services, the scanning of bar codes on a product, by a customer using a wireless terminal is different from its purchase, ie, at

of the Specification, which discloses awarding points “based on the scanning of bar codes associated with products in the store and /or the purchase of scanned products.”)

Advantageously, by awarding points in response to the customer scanning of a product using a wireless bar code reading terminal, as recited in the claims, a customer’s use of the scanning system can be encouraged.

Because Sloane does not teach or suggest awarding of points in response to the scanning of products, as recited in claims 25 and 30, and because this feature is not common knowledge or well-known in the art, applicants submit that the rejection of claims 25 and 30 as being obvious over Sloane in view of Official Notice has been traversed. The rejection of the respective dependent claims has been traversed for at least the same reasons. If the Examiner maintains his rejection on the basis of Official Notice, applicants request that the Examiner produce documentary support for this position.

D. Independent Claim 38

The Examiner has rejected claim 38 “for substantially the same reasons as claim 1”, again basing the rejection on the generic Official Notice that the concepts recited in these claims and not disclosed in Sloane are well known. Applicants disagree.

Claim 38 recites a system for marketing in which a prize is assigned to at least one product and wherein the prize is provided “to a customer in response to at least the reading of a bar code by the customer associated with the at least one product.” Sloane does not teach or suggest awarding a prize as recited in claim 38. Advantageously, by awarding prizes in response to the scanning of a product by a wireless bar code reading

terminal, as recited in the claims, customers use of the scanning system can be encouraged.

Because Sloane does not teach or suggest awarding a prize in response to the scanning of a particular product as recited in claim 38, and because this feature is not common knowledge or well-known in the art, applicants submit that the rejection of claim 38 as being obvious over Sloane in view of Official Notice has been traversed. The rejection of the respective dependent claims has been traversed for at least the same reasons. If the Examiner maintains his rejection on the basis of Official Notice, applicants request that the Examiner produce documentary support for this position.

E. Independent Claim 41

The Examiner has rejected claim 41 “for substantially the same reasons as claim 1”, again basing the rejection on the generic Official Notice that the concepts recited in these claims and not disclosed in Sloane are well known. Applicants disagree.

Claim 41 recites a method of marketing wherein the system maintains and customer information with various account attributes, “related to at least one of present customer coupons, future customers coupons, and present customer scanning points” and “displaying on the customer’s terminal an indication of the status of the customer’s account.”

Sloane does not teach or suggest maintaining a customer account database or displaying the account data on a customer’s scanning terminal as recited in claim 41. Applicants contend that this feature is also not believed to be common knowledge or well-known in the art and, therefore, submit that the rejection of claim 41 as being

obvious over Sloane in view of Official Notice has been traversed. The rejection of the respective dependent claims has been traversed for at least the same reasons. If the Examiner maintains his rejection on the basis of Official Notice, applicants request that the Examiner produce documentary support for this position.

F. Claims 48 and 58

The Examiner has rejected claims 48 and 58 as being obvious over Sloane in view of Official Notice. As with the other rejections, the Examiner admits that Sloane does not disclose the invention as recited the claims, but takes Official Notice that the differences are notoriously well known ways to provide “supplemental information.” Applicants disagree.

Claims 48 and 58 recite a shopping method and system, respectively, which uses a plurality of rechargeable wireless bar code reading terminals. Claim 48 recites the step of “preventing uncharged terminals from being removed by customers [from a recharging terminal station].” Similarly, claim 58 recites “a locking system . . . for preventing uncharged terminals from being removed by customers.” Sloane contains no teaching or suggestion to include a locking method or system, as recited in claims 48 and 58, that prevents a terminal from being removed from a terminal station if its battery is not charged.

With respect to the Examiner’s Official Notice, applicants contend that this feature is not believed to be common knowledge or well-known in the art. Applicants also note that the claimed locking feature is entirely unrelated to “supplemental information” on which the Examiner’s Official Notice is based.

Accordingly, applicants submit that the rejection of claims 48 and 58 as being obvious over Sloane in view of Official Notice has been traversed. The rejection of the respective dependent claims has been traversed for at least the same reasons. If the Examiner maintains his rejection on the basis of Official Notice, applicants request that the Examiner produce documentary support for this position.

G. Independent Claims 35, 44, 47, 68, 69, 70, 73, 75, 80, 105, and 107

The remaining claims (including independent claims 35, 44, 47, 68, 69, 70, 73, 75, 80, 105, and 107 and the respective dependent claims) have been canceled. Accordingly, the rejection of these claims is moot.

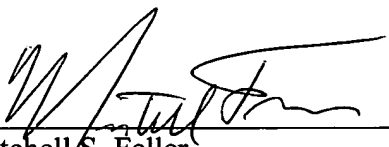


### CONCLUSION

Each and every point raised by the Examiner has been addressed on the basis of the above amendments and remarks and the application is believed to be in condition for allowance. Action to that end is respectfully requested. However, should the Examiner believe that direct contact with the applicants' attorney would advance the progress of the application, the Examiner is invited to telephone the undersigned at the number below.

Respectfully submitted,

Date: September 1, 2004

  
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